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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 10

Application Number: 09/553,010  
Filing Date: April 20, 2000  
Appellant(s): BATES ET AL.

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Scott A. Stinebruner  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/16/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-9, 13, 17-26 and 29-30 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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6393346	Keith et al	5-2002
6006148	Strong	12-1999

(10) **Grounds of Rejection**

The following ground(s) of rejection are applicable claims:

Claims 1-9, 13, 17-26, and 29-30 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No.7. The rejection is set forth below as it appears in Paper No.7.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 7-20 and 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by McMillan et al (6,064,970).

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(A) As per claim 1, McMillan discloses a method of conducting an economic transaction associated with usage of a vehicle over a period of time (Col.5, lines 13-22), the method comprising:

(a) tracking the location of the vehicle during at least a portion of the period of time associated with the economic transaction (Col.3, lines 25-58; Col.6, lines 44-65), including detecting that the vehicle is located at a location having an increased level of risk (Col.8, lines 61-67 to Col.9, line 33); and

(b) adjusting a cost with the economic transaction at least in part based on the location of the vehicle at the location having the increased level of risk (Col.2, lines 5-67 to Col.3, line 58; Col.4, lines 27-67 to Col.5, line 43).

(B) As per claims 2 and 18, McMillan discloses the method wherein the increased level of risk is based on at least one of risk of vehicle theft, risk of injury, risk of crime, risk of vehicle accident, risk of hazardous road conditions, risk of terrorist activity, risk of combat activity, and combination thereof (Col.4, lines 27-67; Col.8, lines 19-25).

(C) As per claims 7 and 24, McMillan discloses the method wherein adjusting the cost associated with the economic transaction includes adding a surcharge to the cost in response to detection of the location of the vehicle at the location having the increased level of risk (Col.4, lines 27-67).

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(D) As per claims 8 and 25, McMillan discloses the method wherein the amount of the surcharge is based on an amount of time that the vehicle is located at the location having the increased level of risk (Col.4, lines 27-67).

(E) As per claims 9 and 26, McMillan discloses the method wherein adjusting the cost associated with the economic transaction includes selected one of a plurality of base upon detection of the location of the vehicle at the location having the increased level of risk (Col.3, lines 61-67 to Col.4, line 67).

(F) As per claims 10 and 27, McMillan discloses the method wherein the economic transaction includes rental of the vehicle (The Examiner interprets economical and practical value for a system intended to provide an enhanced acquisition as a form of economic transaction includes rental of the vehicle Col.3, lines 3-24).

(G) As per claims 11 and 28, McMillan discloses the method wherein the economic transaction includes insurance of the vehicle (Col.3, lines 3-12).

(H) As per claim 12, McMillan discloses the method wherein the economic transaction includes at least one of liability insurance, comprehensive insurance and collision insurance (Col.3, lines 3-12).

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(I) As per claim 13, McMillan discloses a method of renting a vehicle, the method comprising:

(a) tracking the location of the vehicle during at least a portion of a rental period, including detecting that the vehicle is located at a location having an increased level of risk during the rental period (Col.8, lines 61-67 to Col.9, line 33); and

(b) increasing the cost associated with renting the vehicle based on detecting the location of the vehicle at the location having the increased level of risk (Col.2, lines 5-67 to Col.3, line 58; Col.4, lines 27-67 to Col.5, line 43).

(J) As per claim 14, McMillan discloses a method of insuring a vehicle, the method comprising:

(a) tracking the location of the vehicle during at least a portion of a coverage period, including detecting that the vehicle is located at a location having an increased level of risk during the coverage period (Col.8, lines 61-67 to Col.9, line 33); and

(b) setting a premium associated with insuring the vehicle based on detecting the location of the vehicle at the location having the increased level of risk (Col.2, lines 5-67 to Col.3, line 24; Col.4, lines 27-67 to Col.5, line 27).

(K) As per claim 15, McMillan discloses the method wherein setting the premium includes setting the premium for the coverage period (Col.5, lines 13-40).

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(L) As per claim 16, McMillan discloses the method wherein setting the premium includes setting the premium for a subsequent coverage period (Col.5, lines 13-40).

(M) As per claim 17, McMillan discloses an apparatus, comprising:

(a) a vehicle location tracking system configured to track the location of a vehicle during at least a portion of a period of time associated with an economic transaction (;Col.8, lines 61-67 to Col.9, line 33) and

(b) a program configured to receive location information from the vehicle location tracking to identify the location of the vehicle during the portion of the period of time associated with the economic transaction, at least a portion of the location information indicating that the vehicle was located at a location having an increased level of risk (Col.8, lines 26-65), the program further configured to adjust a cost associated with the economic transaction at least in part based on the location of the vehicle at the location having the increased level of risk (Col.10, lines 9-50).

(N) As per claim 19, McMillan discloses the method wherein the vehicle location tracking system comprises a location sensor coupled to the vehicle (Col.6, lines 44-65; Col.9, lines 5-58).

(O) As per claim 20, McMillan discloses the method wherein the location sensor includes a Global Positioning System (GPS) receiver (Col.7, lines 6-21).



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(P) As per claim 23, McMillan discloses the apparatus wherein the vehicle location system is coupled to the vehicle, the apparatus further comprising:

- (a) a billing computer upon which the program executes (Col.10, lines 9-50); and
- (b) a handheld computer configured to interface with the vehicle location tracking system to obtain the location information therefrom, and to interface with the billing computer to download the location information thereto (Col.6, lines 44-65).

(Q) As per claim 29, McMillan discloses a program product, comprising:

- (a) a program configured to receive location information identifying the location of a vehicle during at least a portion of a period of time associated with an economic transaction, at a portion of the location information indicating that the vehicle was located at a location having an increased level of risk (Col.10, lines 9-67), the program further configured to adjust a cost associated with the economic transaction at least in part based on the location of the vehicle at the location having the increased level of risk (Col.9, lines 61-67 to Col.10, lines 9-67).

- (b) a signal bearing medium bearing the program (Col.7, lines 17-21).

Claims 3-6 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan et al (6,064,970) in view of Keith et al (6,393,346).

(A) As per claim 3, McMillan discloses the method wherein tracking the location of the includes:

- (a) calculating the location of the vehicle at a point in time using a location sensor coupled to the vehicle (Col.6, lines 44-64). McMillan does not explicitly disclose (b)

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storing a timestamped entry in a database identifying the point in time and the calculated location of the vehicle at such point in time.

However, this feature is known in the art, as evidenced by Keith. In particular, Keith suggests storing a timestamp entry in a database identifying the point in time and calculated location of the vehicle at such point in time (See Keith Col.1, lines 66-67 to Col.2, line 24; Col.4, lines 1-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Keith within the system of McMillan with the motivation of providing a system and method for recording the distances traveled and the places visited by a monitored vehicle equipped with a navigational receiver and a computer-based datalogger having a clock and an on-board memory so that the datalogger can store time-stamped records of the latitude and longitude of places or destinations visited by the vehicle (See Keith Col.1, lines 66-67 to Col.2, line 5).

(B) As per claim 4, McMillan discloses the method wherein the location sensor includes a Global Positioning System (GPS) receiver (Col.7, lines 6-21).

(C) As per claim 5, McMillan discloses the method wherein tracking the location of the vehicle further includes determining a current region for the vehicle from calculated location, calculating the location of the vehicle includes calculating a second location for the vehicle at a second point in time (Col.3, lines 25-38). McMillan does not explicitly disclose wherein storing the timestamped entry in the database includes storing a

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second timestamped entry in the database for the second calculated location only if the region associated with the second calculated location differs from the region associated with the first calculated location.

However, this feature is known in the art, as evidenced by Keith. In particular, Keith suggests storing the timestamped entry in the database includes storing a second timestamped entry in the database for the second calculated location only if the region associated with the second calculated location differs from the region associated with the first calculated location (See Keith Col.2, lines 1-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Keith within the system of McMillan with the motivation of providing a system and method for recording the distances traveled and the places visited by a monitored vehicle equipped with a navigational receiver and a computer-based datalogger having a clock and an on-board memory so that the datalogger can store time-stamped records of the latitude and longitude of places or destinations visited by the vehicle (See Keith Col.1, lines 66-67 to Col.2, line 5).

(D) As per claim 6, McMillan discloses the method wherein the current region is selected from a plurality of regions, the method further comprising assigning a level of risk to each of the plurality of regions (Col.4, lines 27-67).

(E) As per claim 21, McMillan discloses the apparatus wherein the vehicle location tracking system (Col.6, lines 59-65). McMillan does not explicitly disclose a second

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program configured to store the location in the form of timestamped entries, each identifying one of a plurality of regions and a time at which the vehicle was located in such region, the second program further configured to add a timestamped entry at a second point in time only when a current region for the vehicle at the second point on time differs from a previous region for the vehicle at a first, previous point in time.

However, this feature is known in the art, as evidenced by Keith. In particular, Keith suggests a second program configured to store the location in the form of timestamped entries, each identifying one of a plurality of regions and a time at which the vehicle was located in such region, the second program further configured to add a timestamped entry at a second point in time only when a current region for the vehicle at the second point on time differs from a previous region for the vehicle at a first, previous point in time (Col.4, lines 1-67 to Col.5, line 56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Keith within the system of McMillan with the motivation of providing a system and method for recording the distances traveled and the places visited by a monitored vehicle equipped with a navigational receiver and a computer-based datalogger having a clock and an on-board memory so that the datalogger can store time-stamped records of the latitude and longitude of places or destinations visited by the vehicle (See Keith Col.1, lines 66-67 to Col.2, line 5).

(F) As per claim 22, McMillan discloses the apparatus wherein each of the plurality of regions is associated with a level of risk (Col.6, lines 20-65).

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2. Claims 1-9, 13, 17-26, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan et al (6,064,970) in view of Keith et al (6,393,346), for substantially the same reasons given in the previous Office Action (paper 3), and further in view of Strong (6,006,148).

(A) Claim 1 has been amended to recite a method of conducting an economic transaction "associated with rental" of a vehicle over a period of time. The collective teachings of McMillan and Keith fail to expressly disclose transaction associated with rental" of a vehicle over a period of time. However, such a feature is well known in the art, as evidenced by Strong. In particular, Strong discloses an economic transaction "associated with rental" of a vehicle over a period of time (See Strong, Col. 12, lines 59-67 to Col.13, line 10).

One of ordinary skill in the art at the time of the invention would have found it obvious to incorporate the above features disclosed by Strong within the system taught collectively by McMillan and Keith with the motivation of providing information transmitted to the base station which then routed to a destination computer such as a computer inside the car rental building where the customer may pick up his/her receipt or to a computer on an airport shuttle bus which can also used to print out a receipt or otherwise finalize the customer transaction related to the vehicle drop-off. With the use of this automated vehicle return system, the added time and/ or costs associated with obtaining and processing the mileage, fuel tank information, and other data from a returned vehicle is minimized (See Strong, Col.1, lines 62-67 to Col.2, line 4).

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The remaining features of claim 1 are rejected for the reasons set forth in the previous Office Action, and incorporated herein (Paper number 3, pages 7-8).

(B) The amendments to claims 17 and 29 reflect the same changes made to claim 1, discussed above, and are therefore rejected for the same reasons given above for claim 1 in addition to the rejections made for claims 17 and 29 in the prior Office Action (Paper number 3, pages 7-8).

(C) Claims 2-9, 13, 18-26, and 29-30 have not been amended and are rejected for the same reasons given in the previous Office Action (Paper number 3, pages 7-8).

**(11) Response to Argument**

In the Appeal Brief filed 12/16/03, Appellant makes the following argument:

Claims 1-9, 13, 17-26, and 29-30 are patentable over McMillan et al. in view of Keith et al. and further in view of Strong. In making this argument, Appellant makes the following points:

(i) The present rejection does not establish a prima facie case of obviousness under 35 U.S.C. 103 and M.P.E.P. Sections 2142-2143.

(ii) Neither McMillan nor Keith expressly discloses an economic transaction associated with rental of a vehicle.

(iii) There is no location tracking used in the monitoring circuit for any rental vehicle, nor is vehicle location data ever used in the calculation of the cost of a vehicle rental.

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(iv) There is no motivation to modify McMillan for use in a vehicle rental application.

Appellant respectfully submit that the Examiner has failed to raise a *prima facie* case of obviousness as to claim 1. Indeed, it appears that the Examiner's rejection is based entirely on hindsight, as the only motivation that could be found for modifying McMillan for use in vehicle rental is found in Appellant's disclosure.

(v) The prior art of record does not disclose or suggest each and every feature of claim 5, most notably the combination of determining a region for a vehicle from a location, and storing a timestamped entry in a database only if the vehicle is no longer in the same region.

Examiner will address Appellant's argument and related points in sequence as they appear in the Brief.

(i) With respect to Appellant first point of argument, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has

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presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Appellant's claimed invention. Note, for example, in rejection of claim 1, Examiner had stated the following:

Claim 1 has been amended to recite a method of conducting an economic transaction "associated with rental" of a vehicle over a period of time. The collective teachings of McMillan and Keith fail to expressly disclose transaction associated with rental" of a vehicle over a period of time. However, such a feature is well known in the art, as evidenced by Strong. In particular, Strong discloses an economic transaction "associated with rental" of a vehicle over a period of time (See Strong, Col.9, lines 11-19; Col. 12, lines 59-67 to Col.13, line 10).

One of ordinary skill in the art at the time of the invention would have found it obvious to incorporate the above features disclosed by Strong within the system taught collectively by McMillan and Keith with the motivation of providing information transmitted to the base station which then routed to a destination computer such as a computer inside the car rental building where the customer may pick up his/her receipt or to a computer on an airport shuttle bus which can also used to print out a receipt or otherwise finalize the customer transaction related to the vehicle drop-off. With the use of this automated vehicle return system, the added time and/ or costs associated with obtaining and processing the mileage, fuel tank information, and other data from a returned vehicle is minimized (See Strong, Col.1, lines 62-67 to Col.2, line 4).



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As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinary skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Actions, and incorporated herein, Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(ii) In response to Appellant's second point of argument, it is respectfully submitted that Appellant further fails to properly consider the clear and unmistakable teachings of the applied references, and further fails to properly consider the breadth of the claim limitations presently argued. In particular, the first element in claim 1 is "an economic transaction "associated with rental" of a vehicle over a period of time. This limitation, in and of itself, does not relied upon the references of McMillan and Keith. With this in mind, it is the clear and unmistakable teachings of the Strong's reference that stated "for instance, if the distance the vehicle 32 travels over any given period of time exceeds a certain threshold value such as 75 mph, this information along with the duration for which it lasted may be stored by the vehicle monitoring circuit 70. The rental agency 40 renting this vehicle 32 to this customer could then wirelessly retrieve this information and possibly charge a fine to the customer for extraordinary wear and tear of the vehicle" (See Strong, Col.9, lines 11-19). As such, the Examiner respectfully submits that such terms were given their broadest reasonable interpretations during examination, and since the applied reference clearly discloses the claimed limitations,

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when given their broadest reasonable interpretations, it is respectfully submitted that the Examiner's reliance on Strong is indeed proper.

(iii) With respect to Appellant's third point of argument, Examiner relied on the teaching of Strong for the teachings of "the host computer 52 would compare the current vehicle status data to the pre-rental vehicle status data and calculate a final charge for rental of the vehicle 32. The host computer 52 would then transmit the final charge along with an itemization of charges to cash register 150" (See Strong, Col.12, lines 19-22). As such, Appellant's remarks with regard to the calculation of the cost of a vehicle rental are not persuasive.

(iv) With respect to the Appellant's fourth point of argument, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art by expressly pointing to specific portions of each applied reference and has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical

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reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention.

Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. Within the present combinations, all of the modifications proposed by the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)

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(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Nonetheless, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

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(v) With respect to Appellant's contention that the prior art of record does not disclose or suggest each and every feature of claim 5, most notably the combination of determining a region for a vehicle from a location, and storing a timestamped entry in a database only if the vehicle is no longer in the same region, Examiner respectfully submits that McMillan suggests "tracking of the vehicle for location identification can be implemented by the computer 300 through navigation signals obtained from a GPS (global positioning system) antenna or other locating system 312. The communication link to a central control station is accomplished through the cellular telephone, radio, satellite or other wireless communication system" (See McMillan, Col.6, lines 59-65) which correspond to Appellant's claimed feature. Therefore, Appellant's argument is not persuasive.

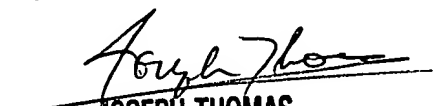
In response to Appellant's piecemeal analysis of the references, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the

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advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of McMillan, Keith and Strong when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Appellant disputes.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,  
Vanel Frenel, *V. F*  
Patent Examiner  
Art Unit 3626  
April 30, 2004

  
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